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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,203	02/14/2002	Glen Kaszubski	MAC-003	7110
38157	7590	07/22/2005	EXAMINER	
THE GLIDDEN COMPANY 15885 WEST SPRAGUE ROAD STRONGVILLE, OH 44136			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/075,203

Applicant(s)

KASZUBSKI ET AL

Examiner

Tae H. Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-23 and 58-91 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 91 is/are allowed.
- 6) ☒ Claim(s) 58-85 and 87-90 is/are rejected.
- 7) ☒ Claim(s) 86 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 80-85 and 87-90 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Imai et al (US 4,760,123) or Staiger et al (US 5,304,621).

Imai et al teach the instant composition in examples 1, 3 and 4, and said composition inherently possesses the instantly recited physical properties. Alkylalkoxy silane components of said examples meet the instant dehydrating agent since it is moisture curable. Various amounts of fillers encompassing the instant amount are taught at col. 8, lines 30-33.

Staiger et al teach the same at col. 7, lines 10-64 and in example 13 wherein  $\alpha$   $\omega$ -di(trimethylsiloxy)dimethylpolysiloxane is seen. Said  $\alpha$   $\omega$ -di(trimethylsiloxy)dimethylpolysiloxane meets the instant dehydrating agent since it is moisture curable. Thus, the instant invention lacks novelty.

Contrary to applicant's assertion, the instant polymers are not carbon-based.

Claims 80-85 and 87-90 are rejected under 35 U.S.C. 103(a) as obvious over Product Brochure "MS polymer Silyl" of Kaneka Corp. in view of Smith, Jr. et al (US 4,308,372), Staiger et al (US 5,304,621) and/or Imai et al (US 4,760,123).

Said Product Brochure teaches the instant formulation #105 (composition) in table of page 5, and it inherently possesses the instant viscosity and Tg. Said MS polymer Silyl meeting the instant (co)polymer having reactive silicon end groups is taught at page 2 wherein the viscosity is also seen (1 Pa • s equals 1,000 centipoise). Said MS polymer has Tg of about - 60 ° C (page 4) and thus said formulation in table of page 5 would have the instant viscosity.

The instant invention further recites employing clear filler such as fumed amorphous silica over Product Brochure. However, said Product Brochure teaches employing various fillers at the bottom of page 1, and the use of said fumed amorphous silica in moisture curable composition having (co)polymer having reactive silicon end groups is well known as taught by Smith, Jr. et al (col. 9, lines 35-57), Staiger et al (col. 7, lines 63-64 and example 13) and Imai et al (col. 8, line 11 and examples 1, 3 and 4, and the fumed silica is amorphous. For example, Staiger et al teach fumed silica, HDK H 15 at col. 18, line 7, which is also taught instant page 6, line 22.

It would have been obvious to one skilled in the art at the time of invention to utilize fumed silica of Smith, Jr. et al, Staiger et al, and/or Imai et al in a composition of Product Brochure as a filler since said Product Brochure teaches employing various

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fillers and since the use of said fumed amorphous silica in moisture curable composition having (co)polymer having reactive silicon end groups is well known and since the use of clear filler is an obvious design choice absent showing otherwise.

Contrary to applicant's assertion, polymers of the cited art do not have to be the same and the secondary references are cited to show the art well known fumed amorphous silica.

Claims 58-72, 74-85 and 87-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 5,298,572) in view of Staiger et al (US 5,304,621) or Baba et al (US 6,013,749).

Katz teaches moisture curable composition at col. 8, table wherein the instant ingredients are seen. The polymers of Katz have the reactive silicon end groups (abstract). The formulation I in said table would meet the recited viscosity and glass transition temperature since it has excellent elongation property (col. 2, line 19). Katz also teaches employing fillers such as fumed silica at col. 6, line 26.

The instant invention further recites surface area of said fumed silica over Katz. However, the use of fumed silica having the recited surface area in curable compositions is well known as taught by Staiger et al, col. 7, lines 63-64, wherein more than 50 m<sup>2</sup>/g is taught. The instant "less than 50 m<sup>2</sup>/g" (encompassing 49.9999) would be an obvious modification of said more than 50 m<sup>2</sup>/g (encompassing 50.0001) since it

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is almost same. Baba et al teach fumed silica having the recited surface area at col. 8, line 39 to col. 9, line 10 wherein Aerosil OX50 used in the instant example is taught.

It would have been obvious to one skilled in the art at the time of invention to utilize fumed silica having the recited surface area of Staiger et al or Baba et al in Katz since Katz teaches employing fumed silica absent any criticality of the surface area.

Claims 58-85 and 87-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz (US 5,298,572) in view of Staiger et al (US 5,304,621) or Baba et al (US 6,013,749), and further in view of Furukawa et al (US 5,459,205) or Yamaguchi et al (US 6,686,047).

Claim 73 further recites particular dehydrating agents, but such dehydrating agents are well known as taught by Furukawa et al (col. 9, lines 39-49) and Yamaguchi et al (col. 9, lines 34-35).

It would have been obvious to one skilled in the art at the time of invention to utilize said dehydrating agents taught by Furukawa et al or Yamaguchi et al in Katz and Staiger et al or Baba et al thereof since Katz teaches the use of a dehydrating agent.

Claim 86 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 91 is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY/July 15, 2005